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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,674	07/13/2001	Natan Elazar Tiefenbrun	2649.7	4290

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/903,674

Applicant(s)

TIEFENBRUN, NATAN ELAZAR

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 – 21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 initially claims the transmission and storage of “risk information” and “trade information.” However, later in Claim 1, Claim 1 claims the transmission of the generically termed “data”, while Claim 2 claims the transmission of the equally generic “information.” Does “data” and “information” refer to none, one or both of the claimed “risk information” and “trade information”?

Then Claim 15, citing dependency upon Claim 1, claims that “data” is “risk data, inventory data, and market data” which seems to indicate that the “communicated data” is separate and distinct from the “trade information” entered into the computer in Claim 1. However, that would mean that the “trade information” is not communicated anywhere as the “trade information” is communicated or transmitted anywhere.

This example is indicative of the § 112, second paragraph, which are replete throughout Claims 1 –21.

Appropriate correction is requested.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 – 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gladstone (PG Pub 2002/0004776) in view of Togher (US Patent 6,014,627) and Official Notice.

**Regarding Claims 1 - 6**, Gladstone discloses an automated bid system, comprising:

- a computer (web server) to host a plurality of software bidding modules (trading accounts) respectively corresponding to a plurality of bidders (users), wherein each software bidding module (trading account) stores at least risk information (trade trigger criteria) for a corresponding bidder. (see p. 1, para. 8 – 10);

- an interface (user interface) through which a client (user) submits to the computer trade information (trade trigger criteria) to solicit bids for executing a desired trade. (see p. 3, para. 27 – p. 4, para. 29); and
- communication means (communications link), for enabling at least one of the plurality of bidders (users) to communicate data (trade trigger criteria) to a corresponding software bidding module (account). (see p. 1, para. 8 – 10);
- wherein at least one of the plurality of software bidding modules (accounts) is configured to respond automatically to the trade information (trade trigger criteria), without human involvement, by communicating or not communicating a bid based on the risk information (trade trigger criteria) stored therein. (see abstract);
- further comprising a bid processor (market analysis software running on processor) through which information is passed (trade trigger criteria) is passed between the interface (user interface) and the computer (financial institution), such that information (trade decision) communicated between the client (user) and the plurality of software bidding modules (marketplace) passes through the bid processor (market analysis software running on processor). (see p. 1, para. 9 – 10);
- wherein the bid processor notifies (informs or issues confirmation to) the client (user) after execution of the desired trade. (see p. 6, para. 42 & 46);
- wherein the trade information includes at least one of: portfolio information (portfolio composition information). (see p. 6, para. 46);

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- wherein the bid processor (market analysis) receives and collates bids from the plurality of software bidding modules (marketplace), and forwards the received bids (market data) to the client (user).

Gladstone does not explicitly state that a system wherein the trade information provided by the client to the computer **cannot be communicated to the plurality of bidders through the communication means**, although such would be assumed as no purpose would be served by disseminating the trigger event criteria of one bidder to other bidders. (emphasis added).

Furthermore, Gladstone does not teach a system wherein the bid processor notifies the client **and one of the plurality of bidders** after execution of the desired trade; wherein the client is given a pre-set time limit to accept one of the received bids; wherein a pre-set amount of time is given to the plurality of bidding modules to respond to the trade information. (emphasis added).

However, Togher discloses a system wherein the trade information (specific credit limitations) provided by the client (client site) to the computer cannot be communicated to the plurality of bidders (potential counterparties) through the communication means. (see col. 2, lines 15 – 32); wherein the client (user) is given a pre-set time limit (predetermined exposure time) to accept one of the received bids (quotes). (see col. 11, lines 8 – 13); wherein a pre-set amount of time (predetermined time exposure) is given to the plurality of bidding modules (acceptable potential counterparties) to respond to the trade information (quote). (see col. 11, lines 8 – 13).

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Examiner takes **Official Notice** that notifying one of the plurality of bidders, such as the counterparty to a trade, after completion execution of a desired trade, such via issuance of a receipt or a trade confirmation, is old and well known in the art of financial systems and information technologies.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gladstone by incorporating the confidentiality of information and expiration time for submitted bids, as disclosed by Togher, thereby providing an anonymous trading environment and allowing bidders to control the lifespan of their quotes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gladstone and Togher by incorporating the notification of one of a plurality of bidders after execution of a desired trade, as is old and well known, as such is standard and conventional in the art of financial transactions.

**Regarding Claims 7 – 21**, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

### ***Response to Arguments***

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Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

**Examiner's Note:** The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



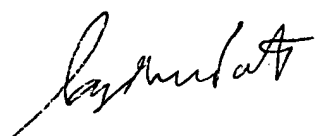
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/16/07  
JAGDISH N. PATEL  
PRIMARY EXAMINER